

REMARKS

The Office action mailed on 28 January 2005 (Paper No. 012405) has been carefully considered.

In paragraph 3 of the final Office action, the Examiner states that claims 1 thru 9 and 11 thru 24 are rejected under 35 U.S.C. §103 for alleged unpatentability over Jansen *et al.*, U.S. Patent No. 6,243,450 in view of Massarani, U.S. Patent No. 6,393,484, and further in view of newly cited Hoguta *et al.*, U.S. Patent No. 6,725,303. However, paragraph 14 of the final Office action, the Examiner sets forth grounds for rejection of claim 10 based on the aforementioned three references. Therefore, it is presumed that claims 1 thru 24 are rejected under 35 U.S.C. §103 based on the three cited references.

Independent claims 1, 10 and 11 recite an internet interface service system and method by means of which high-speed connection services are provided to mobile terminals carried by respective users in public places. Moreover, independent system claims 1 and 11 recite that the system comprises, among other elements, plural interface units, one for each of the mobile terminals, for connecting the mobile terminals of the respective users to the internet network so as to provide the respective users with internet services. This corresponds to the disclosure of Figure 1, which shows a mobile terminal 10 and a corresponding interface unit 1 which connects the mobile terminal 10 to the internet network 5. As mentioned in paragraph [0019] of the specification, the internet

interface service system includes “plural interface units 1 (only one is shown for the sake of simplicity) connected to plural mobile terminals 10 (again, only one is shown)” (quoting from paragraph [0019] of the specification). Thus, the specification supports the amended recitation of the “plural interface units”.

In paragraph 4 of the final Office action, the Examiner states that Jansen *et al.* ‘450 discloses an internet interface service system which includes “plural interface units”, citing item 38 of Figure 2, and stating that a “plurality of terminals are connected to the Central server” (quoting from paragraph 4, lines 3-4 of the Office action). However, item 38 in Jansen *et al.* ‘450 is merely a collection of connection lines referred to as an “intranet” to which a plurality of vendor servers 27 are connected (*see* column 4, lines 3-4 of the patent). Thus, there is no disclosure or suggestion in Jansen *et al.* ‘450 of the plural interface units, one for each of the plurality of mobile terminals, as recited in independent system claims 1 and 11 of the present application, as now amended.

On page 9 of the final Office action, in response to the latter argument, the Examiner expresses disagreement with that argument by stating that the “prior art explicitly teaches multiple terminals are envisioned by the invention” (quoting from the third complete paragraph on page 9 of the final Office action). However, the Examiner does not state where, in the prior art or in the references cited by the Examiner, such a teaching is contained. Thus, there is no evidence on the record to support the Examiner’s

contention.

In the same paragraph on page 9 of the final Office action, the Examiner goes on to state that “[e]ach terminal is an interface unit to the network” (again, quoting from the fourth complete paragraph on page 9 of the final Office action). However, if each terminal in Jansen *et al.* ‘450 is an interface unit as alleged by the Examiner, then Jansen *et al.* ‘450 does not disclose a plurality of terminals connected to such interface units. In other words, if each terminal 10 of Figure 2 of Jansen *et al.* ‘450 is an interface unit as alleged by the Examiner, then what elements in Jansen *et al.* ‘450 correspond to the claimed mobile terminals? That question is not answered in the final Office action.

In paragraph 4 of the final Office action, the Examiner also states that Jansen *et al.* ‘450 discloses a “plurality of terminals” connected to the Central server (*see* paragraph 4, line 4 of the final Office action). However, the system and method of independent claims 1, 10 and 11 is distinguishable from Jansen *et al.* ‘450 by virtue of the recitation of an internet interface service system and method which provides “high-speed connection services to mobile terminals carried by respective users in public places” (quoting from the preamble of independent claims 1, 10 and 11). In contrast, Jansen *et al.* ‘450 actually teaches away from the concept of mobile terminals carried by respective users in public places by disclosing, in Figure 1, a permanently or semi-permanently fixed kiosk apparatus containing a computer 14, a display 16, a keyboard 18, a telephone 20, and

speakers 43 and 45 to be used by any member of the public who is not carrying his/her own mobile terminal. Thus, not only is this apparatus a non-mobile terminal within the context of the recitation contained in the preamble of claims 1, 10 and 11, but also the apparatus shown in Jansen *et al.* '450 does not provide high-speed connection services to mobile terminals carried by respective users in public places, as recited in claims 1, 10 and 11.

In response to the latter argument, on page 9 of the final Office action, the Examiner merely states that "the new grounds of rejection teaches [*sic*] this feature" (quoting from the last line on page 9 of the final Office action). That is, the Examiner alleges that the "new grounds of rejection" set forth mobile terminals. However, there is nothing in the "new grounds of rejection" which disclose or suggest mobile terminals. As mentioned above, the kiosk terminals 10 of Figures 1 and 2 of Jansen *et al.* '450 are connected by wires or communications lines 24, 28 to the public telephone network 22 and/or to central server 26 (*see* Figure 1 of Jansen *et al.* '450). Whereas it is stated that the kiosk 10 may be wirelessly connected to the telephone network 22 or the central server 26, it is clear from Figure 1 that the kiosk 10 is not a mobile terminal which can be carried by respective users in public places, as recited in claims 1, 10 and 11 of the present application. This argument was made previously, and there is nothing in the "new grounds of rejection" set forth in the final Office action to counter this argument.

On page 4 of the final Office action, the Examiner states that the terminals of Jansen *et al.* '450 "can be wirelessly located anywhere and therefore are considered mobile" (quoting from page 4, lines 3-4 of the final Office action). Whereas the Examiner may be correct that, since the terminals can be wirelessly connected to the internet, they can be moved from one location to another, the terminals or kiosks disclosed in Jansen *et al.* '450 (*see* Figure 1, in particular) are clearly not "mobile terminals carried by respective users in public places", as recited in claims 1, 10 and 11. Thus, for this reason alone, the invention recited in the claims is distinguishable from the disclosure of Jansen *et al.* '450 so as to preclude rejection under 35 U.S.C. §103.

On page 3 of the final Office action, the Examiner admits that Jansen *et al.* '450 "does not explicitly teach a central management server allocating dynamic IP addresses" as well as a "central management server being responsive to the mobile terminals receiving from the interface units a signal terminating the internet connections for releasing the dynamic IP addresses allocated to the mobile terminals" (quoting from the first complete paragraph on page 3 of the final Office action). Therefore, the Examiner cites Massarani '484. However, the Examiner does not state where, in the disclosure of Jansen *et al.* '450, there is any statement or motivation or instruction to a person of ordinary skill in the art, motivating or instructing that person to seek and incorporate the disclosures of Massarani '484. Thus, on this additional basis, a rejection under 35 U.S.C. §103 based on the combination of references cited by the Examiner must be considered to

be an invalid combination under the statute.

In response to the latter argument, on page 10 of the final Office action, the Examiner states recognition “that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art” (quoting from page 10, lines 5-8 of the final Office action). However, in the present case, there is no disclosure or suggestion in the references cited by the Examiner of each and every element and function or method step claimed in the present application. In fact, in some respects, the Examiner has admitted that the prior art references cited herein do not disclose or suggest certain elements and functions or method steps as claimed.

With respect to “knowledge generally available to one of ordinary skill in the art” (quoting from page 10, line 8 of the final Office action), the Examiner has not placed on the record any evidence, in the form of prior patents or publications, of what knowledge was generally available to one of ordinary skill in the art as of the date of the invention.

In the latter regard, the Examiner states that “Jansen teaches a pay-per use distributed network service”, that “Massarani teaches a system and method for improving network access in distributed networks in semi-public internet networks”, and that “[t]he

artisan of ordinary skill in implementing the system of Jansen, would have been motivated to implement methods to enhance the efficiency of the network in which the system resides" (quoting from page 10, lines 10-14 of the final Office action). However, these general statements by the Examiner do not amount to an explicit statement as to where, in the prior references cited by the Examiner, there is a disclosure or suggestion of each and every element and function or method step as claimed. Furthermore, with respect to the final statement relative to motivation of the "artisan of ordinary skill", the Examiner does not cite any evidence, in the form of citation to prior patents or publications, to support the Examiner's opinion that the "artisan of ordinary skill in implementing the system of Jansen, would have been motivated to implement methods to enhance the efficiency of the network in which the system resides" (again, quoting from page 10, lines 12-14 of the final Office action). It is submitted that the only reason that the Examiner considers the differences between the claimed invention and the cited references to be "obvious" is that the Examiner, unlike the person of ordinary skill in the art as of the time of the invention, has had the benefit of reviewing and studying the disclosure of the present application, and is exercising improper hindsight in combining the references and modifying the combined disclosure and the references in order to arrive at the present invention. Needless to say, such a practice is an improper practice in combining references under 35 U.S.C. §103.

In the latter regard, it is also noted that Figure 1 of Massarani '484 discloses a

DHCP server 30 and an authentication server 36. Presumably, the DHCP server 30 is alleged by the Examiner to perform the functions of dynamic IP address allocation and release of the dynamic IP addresses allocated to the mobile terminals upon termination of the internet connection, as recited in the claims. However, it is also noted that the arrangement of Figure 1 of Massarani '484 is entirely distinct and different from the arrangement of the central server generally disclosed in Figure 1 and specifically disclosed in Figure 3 of Jansen *et al.* '450. Thus, it is submitted that one of ordinary skill in the art, even if motivated to seek the disclosure of Massarani '484 for the purpose of modifying the disclosure of Jansen *et al.* '450, would not receive sufficient instruction from either of the two references so as to be able to incorporate the server 30 of Massarani '484 into the kiosk apparatus arrangement of Figures 2 and 3 of Jansen *et al.* '450. Moreover, even if one of ordinary skill in the art were so instructed and motivated, it is not clear from the disclosures of the two patents, or from the Office action itself, that incorporation of the server 30 of Massarani '484 into the arrangement of Jansen *et al.* '450 would result in the present invention, as recited in the claims. Thus, on this additional basis, a rejection under 35 U.S.C. §103 based on the combination of references cited by the Examiner must be considered improper, and should be withdrawn.

For the reasons stated above, it is submitted that the inventive system and method, as recited in independent claims 1, 10 and 11, is distinguishable from the prior art cited by the Examiner so as to preclude rejection under 35 U.S.C. §103.

The dependent claims of the present application provide a further basis for distinguishing the invention from the prior art cited. For example, dependent claims 3 and 15 recite that each interface unit comprises a first communication unit and a second communication unit with the functions recited in the claims. In paragraph 6 of the final Office action, the Examiner cites element 104 of Figure 4 of Jansen *et al.* '450 as allegedly corresponding to the recited "first communication unit", and cites elements 46, 48 and 50 of Figure 3 of Jansen *et al.* '450 as allegedly corresponding to the recited "second communication unit". However, it should be recalled that, with respect to the recited "interface units", the Examiner (in paragraph 4 on page 2 of the final Office action) stated that element 38 of Figure 2 of Jansen *et al.* '450 (entitled "intranet") corresponded to the recited "interface units". However, element 38 of Jansen *et al.* '450 appears (in Figure 2 thereof) to be merely communication lines external to, and interconnecting, kiosk terminals 10 to the servers 26 and 27. Furthermore, element 104 of Figure 4 of Jansen *et al.* '450 (which the Examiner states as corresponding to the recited "first communication unit") is an Ethernet interface 104 contained within the multimedia terminal itself (*see* Figure 4 of the patent), whereas claims 3 and 15 (and their preceding claims) make it clear that the interface units, which contain the first and second communication units, are separate and apart from the mobile terminals which they serve. In addition, elements 46, 48 and 50 of Figure 3 of Jansen *et al.* '450 (which, according to the Examiner, correspond to the recited "second communication unit") are individual servers contained within the central server 26 (which, according to the Examiner,

corresponds to the recited “central management server”) of the claims. In contrast, the claimed second communication unit resides in the interface unit which, according to the claims, is an element separate and apart from the central management server recited in the claims.

Further considering dependent claim 3, the Examiner states (on page 5 of the final Office action) that the settlement unit recited in the claims corresponds to element 70 of Figure 3 of Jansen *et al.* ‘450. However, element 70 of Figure 3 of the cited patent is a credit card service “such as a Chemical Bank” (see column 4, lines 65 of Jansen *et al.* ‘450) external to a multimedia terminal and any interface, whereas the settlement unit recited in dependent claim 3 is an element contained within the interface unit associated with the mobile terminal.

In the second paragraph on page 6 of the final Office action, the Examiner alleges that element 82 of Jansen *et al.* ‘450 corresponds to the “control unit” recited in dependent claim 3. However, element 82 of Figure 4 of the cited patent is a microprocessor contained within the multimedia terminal itself, whereas the recited “control unit” is a part of the interface unit which, according to the claims, is an element separate and apart from the mobile terminals.

It should be noted that the observations above relative to the settlement unit and

control unit recited in dependent claim 3 apply also to the settlement unit recited in dependent claim 17 and the control unit recited in dependent claims 20 thru 24. Thus, for the same reasons stated above relative to dependent claim 3, dependent claims 17 and 20 thru 24 provide further basis for distinguishing the invention from the prior art cited by the Examiner so as to preclude rejection under 35 U.S.C. §103.

In the last paragraph on page 5 of the final Office action, the Examiner cites column 2, line 22 - column 3, line 25 of Hoguta *et al.* '303 relative to the "output unit" recited in claim 3. However, a review of the cited portion of Hoguta *et al.* '303 reveals that the reference does not disclose mobile terminals as recited in the claims of the present application. Rather, reference is made to "home terminals" and to "hotel terminals", the latter being customized to look like "home terminals". In any event, the terminals discussed in Hoguta *et al.* '303 are clearly not mobile terminals, but rather are fixed terminals located either in the home of a user or in a hotel which may be used by the user. This raises a question as to the propriety of citing Hoguta *et al.* '303 against the claims of the present application, and a further question as to the propriety of combining Hoguta *et al.* '303 with the other references.


To summarize, the combination of references cited by the Examiner under 35 U.S.C. §103 does not disclose or suggest each and every element and function recited in independent claims 1, 10 and 11, as well as various dependent claims of the present

application. Moreover, there is no statement in the references, or in the Office action, which would provide motivation or instruction to a person of ordinary skill in the art so as to enable that person to seek the secondary references in question, and incorporate those references into a modification of the primary reference so as to render obvious the claimed invention. For these reasons, a rejection under 35 U.S.C. §103 based on the cited combination of references should be considered improper, and should be withdrawn.

In view of the above, it is submitted that the claims of this application are in condition for allowance, and early issuance thereof is solicited. Should any questions remain unresolved, the Examiner is requested to telephone Applicant's attorney.

No fee is incurred by this Response After Final.

Respectfully submitted,


Robert E. Bushnell,
Attorney for the Applicant
Registration No.: 27,774

1522 "K" Street N.W., Suite 300
Washington, D.C. 20005
(202) 408-9040

Folio: P56268
Date: 4/27/05
I.D.: REB/JGS